

REMARKS

Claims 1, 4, 5, 7 to 16, 18 to 29, 32 to 36 and 55 to 58 are the pending claims being examined in the application, of which Claims 1, 23, 25, 27 and 29 are independent. Claims 1, 4, 5, 7 to 16, 18 to 29, 32 to 36 and 55 to 58 are being amended, and Claim 6 is being cancelled without prejudice or disclaimer of the subject matter and independent of any matter raised in the Office Action. Reconsideration and further examination are respectfully requested.

The Office Action raises an objection to Claims 4 to 15, 18 to 22, 36 and 55 to 58 for allegedly informalities. The Office Action, with only a general reference to the MPEP and without providing any specific example with reference to the subject matter recited, objects to each and every one of the dependent claims, and then summarily states that all of the dependent claims fail to further limit the claimed subject matter and that "appropriate correction is required."

The objection does not provide any reference to specific language of the claims, and fails to provide any specific basis for the rejection. In the spirit of providing a response and in an effort to advance prosecution, however, Applicant provides the following response. Claims 4 to 15, 18 to 22, 36 and 55 to 58 clearly further limit the subject matter recited in the claim, or claims, from which they depend. To use just a few of the claims as examples, Claim 4 recites that the table of contents information recited in Claim 1 comprises at least one length of digital content, Claim 5 recites that the at least one processor recited in Claim 1 is further configured to request at least one of a plurality of regions of digitized content from a user device, Claim 7 depends from Claim 5 and recites that the request is generated as a function of a pseudo-random sequence, and Claim 8, recites that the pseudo-random sequence is a function of a network address. As can be seen from the examples provided, the dependent claims of the present Application are in complete compliance with any requirement that a dependent claim further limit the subject matter of the claim(s) from which it depends. Reconsideration and withdrawal of the objection of these claims are therefore respectfully requested. Should the Examiner maintain the objection, the Examiner is respectfully requested to provide specific reasons and grounds for the rejection.

The Office Action seems to repeat the objection to the specification raised in the previous Office Action, as allegedly failing to provide proper antecedent basis for the "master table of contents information" and "master songprint identifier" claim language. The Examiner does not provide a response to Applicant's previous remarks, except to state, at page 17 of the current Office Action, that Applicant's previous remarks are moot in view of the new ground(s) of rejection. Furthermore, the objection fails to reference the current language of Claims 1, 23, 25 and 27 identified in the Examiner's objection raised in the current Office Action. It is unclear from the current Office Action, whether the objection is the same rejection raised by the Examiner in the previous Office Action, whether the objection was an inadvertent error and was not intended to be included in the current Office Action, or whether a new objection was intended. Further clarification is requested.

The Office Action rejects Claims 1, 4 to 16, 18 to 28, 36 and 55 to 58 under 35 U.S.C. 112, second paragraph. The Office Action states:

"Claims 1, 4-16, 18-28, 36, and 55-58 are directed to an apparatus. Specifically, claim 1 is directed to a network server. However, it has been held that a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)). Therefore, as Applicant's claims recite both structure (i.e., a verification database) and method steps (e.g. receive" steps, "determine" steps) Claim 1 is rejected under 112 second paragraph.

Without conceding in any way the correctness of the § 112, second paragraph rejection, Applicant amends Claims 1, 4, 5, 7 to 16, 18 to 28, 36 and 55 to 58 to even more clearly recite structure, and in particular a memory store that comprises a verification database and at least one processor coupled to the memory store. Reconsideration of the § 112, second paragraph rejection of the claims are respectfully requested.

The Office Action further states that:

“It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, Applicant's claims that are directed to "receive" steps, "determine" steps, for example, do not distinguish Applicant's claims from the prior art. Similarly, the type of data that is stored in the database (e.g. "information corresponding to ...") also will not differentiate the claimed database from the database PA (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01.)”

It is unclear whether or not the above paragraph is intended to be a part of the § 112, second paragraph rejection, since it does not appear that any § 112, second paragraph issue is being raised. The holding in *Schreiber* had to do with the “use” or “function” of the apparatus as a whole. In response to an argument that a popcorn popper had a different use, or function, than a prior oil funnel which had the same structure, the *Schreiber* court held that a new use for a known apparatus was not patentable. It is worth noting that the holding in *Schreiber* had nothing to do with § 112, second paragraph, but was addressing claim rejections based on art. As is discussed below, the claims of the present application are patentable over the applied art, since the applied art fails to teach, suggest or disclose multiple elements of the claims. Furthermore, the Applicant respectfully disagrees with the Examiner with regard to data structures. Reference is respectfully made to *In re Lowry*, for example, in which the court reversed a § 102 rejection based on prior art, and expressly held a data structure to be patentable over the prior art.

In any event and without conceding the correctness of the rejection and as stated above, Claims 1, 4, 5, 7 to 16, 18 to 28, 36 and 55 to 58 have been amended to even more clearly recite structure, including a store that stores a verification database, at least one processor coupled to the store, the processor having a configuration as recited in the claims.

The Office Action rejects Claims 1 to 36 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,611,812 (Hurtado) and U.S. Patent No. 6,807,632 (Carpentier). Reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action continues to maintain, and Applicant agrees, that Hurtado fails to teach, suggest or disclose the claimed songprint identifier. It follows then that Hurtado cannot disclose a verification database store comprising songprint identifiers derived from digitized content masters, and/or receiving from a user device a songprint identifier derived from digitized content at the user device, and determining whether or not to provide information authorizing play of the digitized content at the user device, the determination being made using the received table of contents information and at least one songprint identifier.

The above differences are in addition to the fundamental differences previously noted by the Applicant between the invention of the present claims and Hurtado. More particularly, Hurtado does not even make content available to a user until after the user receives a license. It is only after the user received the license for the content that the user requests the content at the final stage described in Hurtado. It should be clear then that Hurtado cannot teach, suggest or disclose a songprint identifier derived from digitized content at a user device, and/or determining whether or not to provide information authorizing play of digitized content at the user device using the received songprint identifier derived from digitized content at the user device, let alone using the received songprint identifier derived from digitized content at the user device to make such a determination.

Carpentier fails to cure the deficiencies of the § 103(a) rejection admitted in the Office Action. Carpentier describes a system which facilitates the copying of files to a computer, and uses a mechanism to determine that the copied file is the file requested by the computer. According to Carpentier, at col. 1, lines 14 to 20:

“[t]he present invention relates generally to methods and apparatuses for encapsulating information, identifying the information, representing the information, and facilitating the transfer of the information between users, between remote storage and an originating user, or between remote storages using computers and digital telecommunication networks.”

In stark contrast to determining whether or not to provide information authorizing play of digitized content, Carpentier's focus is on facilitating the copying of files. Carpentier uses a descriptor and an “e-clip” to facilitate copying and to facilitate the identification of the file to be copied. Carpentier uses a descriptor and an “e-clip” to determine whether to retrieve another

copy of a file, not to determine whether or not to provide information authorizing play of digitized content at a user device. Even assuming that one or both of the descriptor and the "e-clip" correspond to the claimed songprint identifier (and assumption that is in no way conceded), it should be clear that Carpentier's process and system are configured to facilitate copying using the descriptor and e-clip, which is much different than the claimed at least one processor configured to determine whether or not to provide information authorizing play of the digitized content at the user device using the claimed songprint identifier.

Nothing in Hurtado or Carpentier, either alone or in the hypothetical combination (which hypothetical combination is believed to be improper as discussed below), can be said to teach, suggest or disclose a memory store comprising a verification database, the verification database comprising master table of contents information and at least one master songprint identifier for each of a plurality of digitized content masters, let alone the claimed system which comprising such a verification database store and at least one processor configured to receive table of contents information and at least one songprint identifier derived from digitized content at a user computer and to determine whether or not to provide information authorizing play of the digitized content at the user computer using the verification database together with the received table of contents information and the at least one songprint identifier.

The hypothetical combination (if such combination is even proper, a fact that is in no way conceded) suggested in the Office Action therefore lacks multiple features of the claims. The § 103(a) rejection of the claims should be withdrawn, and these claims should be deemed patentable over the hypothetical combination suggested in the Office Action.

In accordance with Claims 23, 25 and 27, the claimed network server requests at least one of a plurality of regions of digitized content from the at least one of a plurality of computers from which the table of contents information and songprint identifiers are received. The regions of digitized content are requested as a function of whether or not the received table of contents information correlates with any of the plurality of table of contents information of the verification database (Claim 23), the received at least one songprint identifier correlates with any of the plurality of songprint identifiers of the verification database (Claim 25), or both (Claim 27).

The Office Action cites columns 16 and 17 of Hurtado. The cited portion of Hurtado describes using a digital signature consisting of a message digest to verify a message. In

particular, Hurtado describes that two digital signatures both derived from the same message can be compared to verify the message. Hurtado cannot be said to teach suggest or disclose requesting regions of digitized content at a user device as a function of whether or not received table of contents information correlates with any of a plurality of table of contents information corresponding to digitized content masters of a verification database, requesting regions of digitized content as a function of whether or not received at least one songprint identifier correlates with any of a plurality of songprint identifiers corresponding to digitized content masters of a verification database, or requesting regions of digitized content as a function of whether or not received table of contents information correlates with any of a plurality of table of contents information corresponding to digitized content masters of a verification database and received at least one songprint identifier correlates with any of a plurality of songprint identifiers corresponding to digitized content masters of a verification database.

For at least the foregoing reasons, the § 103(a) rejection of the claims should be withdrawn, and Claims 1, 4, 5, 7 to 16, 18 to 29, 32 to 36 and 55 to 58 should be deemed patentable over the hypothetical combination suggested in the Office Action.

In view of the foregoing and for at least the reasons discussed above, Claims 2, 7, 12, 27, 29 to 32, 54, 56 to 59, 70, 82 and 84 to 87 are believed to be in condition for allowance.

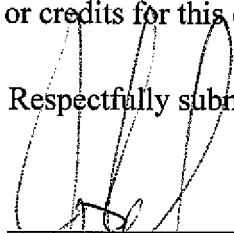
Furthermore, in view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 32361.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,



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